



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

100

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|---------------------|
| 09/939,883 | 08/27/2001 | Volker Breu | 20725 | 4828 |
| 151 | 7590 | 04/21/2004 | EXAMINER | |
| HOFFMANN-LA ROCHE INC. PATENT LAW DEPARTMENT 340 KINGSLAND STREET NUTLEY, NJ 07110 | | | | TRUONG, TAMTHOM NGO |
| ART UNIT | | PAPER NUMBER | | |
| | | 1624 | | |

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|--------------------------------------|-------------------------|
| | 09/939,883 | BREU ET AL. |
| | Examiner Tamthom N. Truong | Art Unit 1624 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 January 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-6,8, 9, 11-15,17-38, 48-78, 82-86 and 92-96 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-4,6,14,15,17-19,48,49,59,70-72,75,76,82-84 and 92 is/are rejected.

7) Claim(s) 2-4,11-13,20-38,50-58,60-69,73,74,77,78,85,86 and 93-96 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4,6.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: ____.

DETAILED ACTION

Applicant's amendment of 01-23-04 has been considered. The amended claims have overcome the previous rejection of 112/2nd by amending the definition of R⁸ to include "alkylene", and not "alkyl". Also, claim 49 has been amended to recite "R⁸" as opposed to R⁹. Thus, the previous 112/2nd rejection is withdrawn herein.

Claims 7, 10, 16, 39-47, 79-81, 87-91, and 97-145 have been cancelled. Therefore, only claims 1-6, 8, 9, 11-15, 17-38, 48-78, 82-86, and 92-96 are pending.

The cancellation of non-elected subject matter is appreciated.

An update search yields a reference having one common inventor, and thus, prompts the following new ground of rejection.

Double Patenting

The **nonstatutory double patenting** rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-4, 6, 14, 15, 17-19, 48, 49, 59, 70-72, 75, 76, 82-84, and 92 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5-9 of U.S. Patent No. 6,696,467 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds of formula I of US'467 overlap with those of the instant formula I when the reference's R¹ and R² "form a 5- to 10-membered heterocyclic ring", which reads on the definition of the instant R³ as a *a heteroaryl group*. Although claim 1 of US'467 does not indicate whether the *heterocyclic ring* is aromatic, in the specification, the examples of such a heterocyclyl group include *pyridinyl, fury, thiophenyl* which are aromatic. Thus, it would have been obvious the scope of formula I in US'467 encompasses the scope of the instant formula I.

Claim Objections

2. Claims 2-4, 11-13, 20-38, 50-58, 60-69, 73, 74, 77, 78, 85, 86, and 93-96 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

3. Also, claim 11 is an improper dependent claim because it depends on the cancelled claim 11.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (~10 am ~ 6:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at 571-272-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting SPE of 1624, at 571-272-0661.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



RICHARD L. RAYMOND
PRIMARY EXAMINER
ART UNIT 1624



T. Truong

April 15, 2004